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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Motoji Ohmori

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EXAMINER

NGUYEN, MINH DIEU T

ART UNIT

PAPER NUMBER

2438

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/577,435	Applicant(s) OHMORI ET AL.	
	Examiner MINH DIEU NGUYEN	Art Unit 2438	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-23 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/27/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the communication dated 4/27/2006.
2. Claims 10-23 are pending.

Information Disclosure Statement

3. The information disclosure statement filed 4/27/06 has been placed in the application file and the information referred to therein has been considered as to the merits.

Claim Objections

4. Claim 16 is objected to because of the following informalities:

As to claim 16, the phrase "the digital content" should be on the same line instead of "content" starts at the beginning of the next line as it appears on the recited claim. The phrase "the digital content" should be --a digital content--; the phrase "indicating history of a digital content" should be -- indicating history of **the** digital content--; the phrase "where a digital content that is accessed" should be --where the digital content that is accessed--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites registering the additional identification information in the case where the authenticity of the unique information and authentication information is verified. Once the condition is met, the additional identification information is registered. Why the unregistered additional identification information judgment unit judges that the additional identification information is not registered. It appears that the recited limitation contradicts to itself.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 22-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 22 recites a program for a server that detects an unauthorized terminal from terminals, it is directed to the program itself, not a process, not a machine nor a manufacture structurally and functionally interconnected with the program in a manner which enables the program to act a computer component and realize its functionality. It's also clearly not directed to a composition of matter. As

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such it fails to fall within a statutory category of invention. Claim 23 is rejected by the same rationale applied against claim 22.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 10-13, 15 and 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitani et al. (2005/0160284) in view of Urano et al. (6,202,158).

a) As to claims 10-11 and 18-23, Kitani discloses a server that detects an unauthorized terminal from terminals, said server comprising: a terminal information receiving unit operable to receive terminal information from each terminal, the terminal information including: one of unique information that is previously assigned to the

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terminal and authentication information that is defined based on the unique information; a terminal information holding unit operable to hold server terminal information including pieces of terminal information; a terminal information search unit operable to search the server terminal information held in said terminal information holding unit based on the received terminal information (i.e. the medium ID and the medium key block (MKB) are the first information unique to the recording medium (Kitani: 0068); the device keys 21 and 31 is information unique to a valid electronic apparatus (Kitani: 0072); authentication control code (ACC) causes the DVD drive and the host to authenticate each other uniquely (Kitani: 0086); ACC is transferred to the host, and it is used along with the exchanged random numbers to generate a session key (Kitani: 0093-0094); the DVD drive calculates a MAC value based on the MKB and the session key and transfers the resultant data to the host (Kitani: 0097). Kitani discloses identical one of the unique information and the authentication information defined based on the unique information as a result of the search (i.e. when the calculated MAC value matches, the host determines that the received MKB and medium ID are valid and causes the process to advance (Kitani: 0099)). However Kitani is silent on the capability of assigning additional identification information to the terminal and judging that the terminal is an unauthorized terminal in the case where the number of different pieces of additional information is equal to or greater than a predetermined number.

Urano is relied on for the teaching of assigning additional identification information to the terminal and judging that the terminal is an unauthorized terminal in the case where the number of different pieces of additional information is equal to or

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grater than a predetermined number (i.e. A place of a terminal from which the log-in operation has been performed can be sometimes specified on the basis of the user's name, the name of the local computer or the name of the input computer, Urano: col. 4, lines 30-34; there is an illegal access when the number of computer terminals which have performed the log-in operations exceeds the predetermined reference value, Urano: col. 9, lines 26-47).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of assigning additional identification information to the terminal and judging that the terminal is an unauthorized terminal in the case where the number of different pieces of additional information is equal to or grater than a predetermined number in the system of Kitani, as Urano teaches so as to effectively detect illegal terminals (Urano: col. 2, lines 10-14).

b) As to claim 12, the combination of Kitani and Urano discloses wherein additional identification information included in terminal information received by said terminal information receiving unit is information concerning a user who uses the terminal (Urano: col. 3, lines 35-44).

c) As to claim 13, the combination of Kitani and Urano discloses wherein additional identification information is information that an owner of the terminal inputs into the terminal (Urano: col. 2, lines 55-61).

d) As to claim 15, as best understood, the combination of Kitani and Urano discloses a receiving unit operable to receive the additional identification information from an operator of said server; and an unregistered additional identification information

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judgment unit operable to judge whether the received additional identification information is registered in terminal information held in said terminal information search unit, wherein the terminal information search unit is further operable to register the additional identification information in the case where the authenticity of one of the unique information and the authentication information is verified and said unregistered additional identification information judgment unit judges that the additional identification information is not registered (Urano: col. 9, lines 26-47).

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitani et al. (2005/0160284) in view of Urano et al. (6,202,158) and further in view of Colvin (2004/0117663).

The combination of Kitani and Urano is silent on the capability of having the additional identification information is an IP address of the terminal. Colvin is relied on the teaching of having the additional identification information is an IP address of the terminal (i.e. device specific information may include a dynamic or static hardware and/or software network address associated with a specific component such as a network adapter including a MAC address or IP address, Colvin: 0105, 0136).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of having the additional identification information is an IP address of the terminal in the system of Kitani and Urano, as Colvin teaches, so as to improve the veracity of the information (Colvin: 0105).

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12. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitani et al. (2005/0160284) in view of Urano et al. (6,202,158) and further in view of Kawakami et al. (7,266,202).

The combination of Kitani and Urano discloses by a terminal that has an identical (i) one of the unique information and the authentication information and (ii) the identical additional identification information as addressed in above claim 10, however it is silent on the teaching of the terminal is permitted to access the digital content related to a predetermined package content at predetermined times by accessing said server via the network; said server further comprising a history holding unit operable to hold information indicating history of a digital content that is accessed by the terminal in a unit of each terminal specified by a pair of (i) one of the unique information and the authentication information and (ii) the additional identification information, wherein said unauthorized terminal judgment unit is further operable to judge that the terminal is an unauthorized terminal in the case where a digital content that is accessed, exceeding the access limit.

Kawakami is relied on for the teaching of the terminal is permitted to access the digital content related to a predetermined package content at predetermined times by accessing said server via the network; said server further comprising a history holding unit operable to hold information indicating history of a digital content that is accessed by the terminal in a unit of each terminal specified by a pair of (i) one of the unique information and the authentication information and (ii) the additional identification information, wherein said unauthorized terminal judgment unit is further operable to

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judge that the terminal is an unauthorized terminal in the case where a digital content that is accessed, exceeding the access limit (Kawakami: col. 11, lines 19-34, col. 17, lines 15-20; col. 28, line 57 to col. 29, line 17).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of the terminal is permitted to access the digital content related to a predetermined package content at predetermined times by accessing said server via the network; said server further comprising a history holding unit operable to hold information indicating history of a digital content that is accessed by the terminal in a unit of each terminal specified by a pair of (i) one of the unique information and the authentication information and (ii) the additional identification information, wherein said unauthorized terminal judgment unit is further operable to judge that the terminal is an unauthorized terminal in the case where a digital content that is accessed, exceeding the access limit in the system of Kitani and Urano, as Kawakami teaches so as to inhibit fraudulent copying of data (Kawakami: col. 1, lines 7-14).

13. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitani et al. (2005/0160284) in view of Urano et al. (6,202,158) in view of Kawakami et al. (7,266,202) and further in view of Lisanke et al. (7,346,580).

The combination of Kitani, Urano and Kawakami is silent on the teaching one of the unique information and the authentication information is one of a secret key in a secret key encryption method and a public key certificate in a public key encryption method. Lisanke is relied on for the teaching of one of the unique information and the

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authentication information is one of a secret key in a secret key encryption method and a public key certificate in a public key encryption method (Lisanke: col. 16, lines 33-39; col. 18, lines 12-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of one of the unique information and the authentication information is one of a secret key in a secret key encryption method and a public key certificate in a public key encryption method in the system of Kitani, Urano and Kawakami, as Lisanke teaches, so as to inhibit unauthorized rerecording of multimedia content (Lisanke: col. 1, lines 34-38).

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dieu Nguyen whose telephone number is 571-272-3873.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Taghi T. Arani can be reached on 571-272-3787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Minh Dieu Nguyen/
Primary Examiner, Art Unit 2438